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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,200	12/19/2000	Heung-For Cheng	42390P10465	7689

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EXAMINER

NGUYEN, CINDY

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/741,200

Applicant(s)

CHENG, HEUNG-FOR

Examiner

Cindy Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner..

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This is in response to application filed on December 19, 2000 in which claims 1-19 are presented for examination.

1. Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

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(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

There is no Brief Summary of the Invention. Correction is required.

2. Drawings

Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cuomo et al. (U.S 6012092) (Cuomo) in view of Goodhand et al. (U.S 5923848) (Goodhand) and further in view of Milewski et al. (U.S 5930471) (Milewski).

Regarding claims 1 and 11, Cuomo disclose: A method and an apparatus for reducing network bandwidth wastage incident to sending an electronic document to a nonexistent member of a distribution list (col. 5, lines 8-18, Cuomo), comprising: a machine accessible medium

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having instructions encoded thereon, which when executed by the machine (col. 3, lines 4-15, Cuomo), are capable of directing the machine to perform receiving a document by a document distribution server (col. 3, lines 48-62, Cuomo); recording in a database an identifier for the document and the distribution list (col. 4, lines 5-12, Cuomo); distributing the document to said members of the distribution list (col. 5, lines 41-49, Cuomo);

However, Cuomo didn't disclose: receiving, in response to distributing to a first member of the distribution list, an error message comprising the identifier. On the other hand, Milewski disclose: receiving, in response to distributing to a first member of the distribution list, an error message comprising the identifier (col. 11, lines 17-34, Milewski). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the instructions for the step for receiving error message in the system of Cuomo as taught by Milewski. The motivation being to inform the user of invalid identifiers.

Furthermore, Cuomo/Milewski didn't disclose looking up the identifier in the database so as to identify the distribution list and deleting the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages. On the other hand, Goodhand discloses: looking up the identifier in the database so as to identify the distribution list (col. 13, lines 21-39, Goodhand); and deleting the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages (col. 13, lines 40-54, Goodhand). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the instructions for deleting the member that no longer exist in the list in the combination system

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of Cuomo/Milewski as taught by Goodhand. The motivation being to enable the user to control the distribution list for removing nonexistent members.

Regarding claim 2, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Cuomo/Milewski /Goodhand disclose: wherein said wastage comprises bandwidth required for: said distributing the document to the nonexistent member(col. 5, lines 41-49, Cuomo); said error message received in response to said distributing; a reply by a second member of the distribution list, in response to said distributing, which is distributed to the nonexistent member; and an error message responsive to said reply (col. 11, lines 1-34, Milewski). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the instructions for error message responsive in the combination system of Cuomo/Goodhand as taught by Milewski. The motivation being to enable the user to control the distribution list for removing nonexistent members.

Regarding claims 3 and 12, all the limitations of these claims have been noted in the rejection of claims 1 and 11, respectively. In addition, Cuomo/Milewski/Goodhand disclose: wherein members of the distribution list receive distributions addressed such that replies to said distributions are directed to said members of the distribution list (col. 5, lines 19-40, Cuomo).

Regarding claims 4 and 13, all the limitations of these claims have been noted in the rejection of claims 3 and 12, respectively. In addition, Cuomo/Milewski/Goodhand: disposing a Messaging Application Programming Interface (MAPI) application program within a first

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computing device (col. 13, lines 52-67, Goodhand); composing by the user of the document with said application program (col. 15, lines 64 to 16, col. 6, Goodhand); and disposing the document distribution server in a second computing device (col. 15, lines 50-57, Goodhand). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the MAPI instructions for composing and disposing message in the combination system of Cuomo/ Milewski as taught by Goodhand. The motivation being to enable the user to communicate with others by messaging.

Regarding claims 5 and 14, all the limitations of these claims have been noted in the rejection of claims 4 and 11, respectively. In addition, Cuomo/Milewski/Goodhand disclose: wherein said application program includes an object-oriented programming language (col. 3, lines 4-15, Cuomo).

Regarding claims 6 and 15, all the limitations of these claims have been noted in the rejection of claims 4 and 11, respectively. In addition, Cuomo/Milewski/Goodhand disclose: wherein said application program comprises a Microsoft outlook e-mail functionality (col. 8, lines 37-49, Goodhand). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include Microsoft outlook e-mail functionality in the system of Cuomo/Milewski as taught by Goodhand. The motivation being to organize the data.

Regarding claim 7, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Cuomo/Milewski/Goodhand disclose: providing a Microsoft windows

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operating system environment having a messaging application programming interface (MAPI) (col. 15, lines 27-34, Goodhand); disposing a Messaging Application Programming Interface (MAPI) application program within a first computing device (col. 13, lines 52-67, Goodhand); composing by the user of the document with said application program (col. 15, lines 64 to col. 16, lines 6, Goodhand); and disposing the document distribution server in a second computing device (col. 15, lines 15-67, Goodhand).

Regarding claims 8 and 17, Cuomo/Milewski/Goodhand disclose: A method and an apparatus for reducing network bandwidth wastage incident to sending an electronic document to a nonexistent member of a distribution list (col. 5, lines 8-18, Cuomo), comprising: recording in a database an identifier cross-referencing the electronic document with the distribution list (col. 4, lines 5-12, Cuomo); distributing the electronic document to members of the distribution list (col. 5, lines 41-49, Cuomo);

Milewski disclose: receiving an error message for said distributing to the nonexistent member, said error message comprising the identifier (col. 11, lines 17-34, Milewski). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the instructions for the step for receiving error message in the system of Cuomo as taught by Milewski. The motivation being to inform the user of invalid identifiers.

Goodhand disclose: sending the electronic document with said MAPI application program col. 14, lines 9-25, Goodhand); executing an e-mail application program utilizing a selected one of: Microsoft Messaging Application Programming Interface (MAPI)-based, and Microsoft Active Messaging (col. 13, lines 1-10, Goodhand); addressing the electronic document

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to the distribution list (col. 13, lines 29-39, Goodhand); looking up the identifier of said error message in the database so as to identify the distribution list (col. 13, lines 21-39, Goodhand); and deleting the nonexistent member from the distribution list (col. 13, lines 40-54, Goodhand). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the instructions for deleting the member that no longer exist in the list in the combination system of Cuomo/Milewski as taught by Goodhand. The motivation being to enable the user to control the distribution list for removing nonexistent members.

Regarding claims 9 and 18, all the limitations of these claims have been noted in the rejection of claims 8 and 17, respectively. In addition, Cuomo/Milewski/Goodhand disclose: further comprising: receiving the error message (col. 11, lines 17-34, Milewski); receiving the electronic document by a distribution server which performs said distributing the electronic document (col. 13, lines 11-20, Goodhand), and looking up the identifier (col. 13, lines 29-39, Goodhand).

Regarding claims 10 and 19, all the limitations of these claims have been noted in the rejection of claims 8 and 17, respectively. In addition, Cuomo/Milewski/Goodhand disclose: further comprising: determining the identifier based on attributes of the electronic document, said attributes comprising a subject identifier, a sending time, and a distribution list identifier (col. 15, lines 50-57, Goodhand). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the step of determining the identifier based on attributes of the electronic document, said attributes comprising a subject identifier, a

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sending time, and a distribution list identifier in the list in the combination system of Cuomo/Milewski as taught by Goodhand. The motivation being to enable the user to control the distribution list and organize the data.

Regarding claim 16, all the limitations of this claim have been noted in the rejection of claim 11. In addition, Cuomo/Milewski/Goodhand disclose: further comprising: a second computing device, communicatively coupled to the system, in which the document distribution server is disposed (col. 15, lines 15-25, Goodhand); and wherein said instructions include further instructions capable of directing the machine to perform: executing a Microsoft Windows operating system environment providing a Messaging Application Programming Interface (col. 15, lines 27-34, Goodhand).

5. Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Christie et al. (U.S 5757669), Method and apparatus for workgroup information replication.

Gilchrist et al. (U.S 6205471), Object oriented mail server framework mechanism.

6. Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 703-305-4698. The examiner can normally be reached on M-F: 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

cn

Cindy Nguyen
November 14, 2002

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